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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/994,388	11/26/2001	Ronald R. Williams	WILLIAMS#7	8481
7590	10/06/2005		EXAMINER	
W. Edward Johansen 11661 San Vicente Boulevard Los Angeles, CA 90049			NGUYEN, LUONG TRUNG	
			ART UNIT	PAPER NUMBER
			2612	

DATE MAILED: 10/06/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/994,388	Applicant(s) WILLIAMS, RONALD R.	
	Examiner LUONG T. NGUYEN	Art Unit 2612	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 November 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 26 November 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Double Patenting

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 1, 5 and 6, 10 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 2, 4, 5 of U.S. Patent No. 5,771,067.

Although the conflicting claims are not identical, they are not patentably distinct from each other because of the reasons discussed below.

Application claims 1, 5 are fully disclosed in and covered by claims 2, 4, 5 of U. S. Patent No. 5,771,067. Both the claims 1, 5 of the instant application and claims 2, 4, 5 of U. S. Patent No. 5,771,067 recite the same invention, for example, application claim 1 recites *a fixed lens system* (corresponds to first achromatic lens of Patent claim 2, column 15, lines 19-20); *a sleeve slidably coupled to said housing* (corresponds to second sleeve, Patent claim 2, column 15, lines 22-26); *an adjustable fixed lens system* (corresponds to second achromatic lens, Patent claim 2, column 15, lines 27-28); *a charge couple device* (corresponds to CCD camera, Patent claim 2, column 15, lines 7-9, column 16, lines 2-6); *a mechanism* (corresponds to mechanism,

Art Unit: 2612

Patent claim 2, column 16, lines 7-16); *a plurality of lamps* (Patent claim 5 recites a light source which includes at least one lamp, this indicates that the light source can have more than one lamp); application claim 5 recites *a transmitter* (corresponds to transmitter, Patent claim 4, column 16, lines 20-23). The Patent claims 2, 4, 5, do not disclose *a battery* as recited in application claim 5. However, this limitation is inherently included, since Patent claims 2, 4, 5 disclose a light source, which provides direct illumination (Patent claim 5, column 16, lines 24-26).

In view of the above, since the subject matters recited in the claims 1, 5 of the instant application are fully disclosed and covered by the claims 2, 4, 5 of U. S. Patent No. 5,771,067, allowing the claims 1, 5 of the instant application would result in an unjustified or improper timewise extension of the “right to exclude” granted by a patent.

As for Application claims 6, 10, see examiner’s comments regarding application claims 1, 5 as discussed above.

3. Claims 2 and 7 rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 2, 4, 5 of U.S. Patent No. 5,771,067 in view of Donahoo (U. S. Patent No. 5,528,432).

Regarding Application claims 2 and 7, the claims 2, 4, 5 of U.S. Patent No. 5,771,067 fail to specifically disclose a pentaprism. However, Donahoo teaches an intra-oral video camera, which includes a prism 62 couples to focusing means 28 and CCD 26, figure 3, column 3, line 40 – column 4, line 45, column 5, lines 12-17). Therefore, it would have been obvious to one of the

Art Unit: 2612

ordinary skill in the art at the time the invention was made to modify the device of Patent claims 2, 4, 5 by the teaching of Donahoo in order to reflect the light to a desired angle from the optical axis of the lens system.

4. Claims 3, 4, 8, 9 rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 2, 4, 5 of U.S. Patent No. 5,771,067 in view of Cooper et al. (U. S. Patent No. 5,051,823).

Regarding Application claims 3, 4, 8, 9, the claims 2, 4, 5 of U.S. Patent No. 5,771,067 fail to specifically disclose each of said lamps comprises a light emitting diode. However, Cooper et al. discloses a video dental camera, which includes a laser diode for emitting light (column 2, lines 50-59, column 5, lines 65-67). Therefore, it would have been obvious to one of the ordinary skill in the art at the time the invention was made to modify the device of Patent claims 2, 4, 5 by the teaching of Cooper et al. in order to provide a dental instrument, which allows the dental practitioner to direct laser energy to a desired location within a patient's mouth (column 3, lines 34-37).

Conclusion

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Cooper et al. (US 4,757,381) discloses means and structure for prevention of cross contamination during use of dental camera.

Cooper et al. (US 5,016,098) discloses electronic video dental camera.

Art Unit: 2612

Toda et al. (US 5,047,847) discloses endoscope using liquid crystal devices different in the response frequency in the image forming optical system.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to LUONG T. NGUYEN whose telephone number is (571) 272-7315. The examiner can normally be reached on 7:30AM - 5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, NGOCYEN VU can be reached on (571) 272-7320. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

LN
10/02/05



LUONG T. NGUYEN
PATENT EXAMINER